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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/930,702	02/13/98	WETZEL	T CPW50075/US

EXAMINER

HM22/0623

BAWA, R

ART UNIT	PAPER NUMBER
1615	9

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PATENT & TRADEMARK ADMINISTRATOR
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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on ______

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.
Of the above, claim(s) ______ is/are withdrawn from consideration.
☐ Claim(s) ______ is/are allowed.
☒ Claim(s) 1-23 is/are rejected.
☐ Claim(s) ______ is/are objected to.
☐ Claim(s) ______ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on ______ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on ______ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.
☐ received in Application No. (Series Code/Serial Number) ______.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: ______.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, ~~Paper No(s)~~. ______
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

DETAILED ACTION

(1) The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The terms precursors and derivatives are vague in the context of the present disclosure which does not describe what compounds are intended by such description. Accordingly, one skilled in the art would not be able to make and/or use the invention as claimed.

(2) Claims 11,13,15,22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, "very high" is indefinite since it is a relative term.

In claim 13 and 15, parenthetical information renders the claim indefinite. Removal of the parentheses is requested.

In claims 22 and 23, "particularly..." is vague and indefinite as it is unclear which temperature range is intended by the claim language.

It is the Examiner's position that the above phrases do not meet the threshold requirement of clarity and precision and are not in compliance for definiteness of 35 U.S.C. 112, second paragraph.

(3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-23 are rejected under 35 U.S.C. 102(b) or 102(e) as being anticipated by Hague, US 5,543,074, Procter & Gamble, WO 94/17166, Unilever, EP 0 485 212 A1 or Patterson, US 5,248,495.

Each reference teaches the claimed combination of surfactant, fatty amphiphile and an optional hydrocolloid. See Hague at col.2; col.3, lines 20-60; col. 4, lines 23-70; col.5, lines 1-41; col. 6, lines 33-35; example 1 at col.8. Note that Hague also teaches a dispersion temperature of approximately 50 degrees.

(4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hague, US 5,543,074, Procter & Gamble, WO 94/17166, Unilever, EP 0 485 212 A1 or Patterson, US 5,248,495.

It is the examiner's primary position that the claimed invention is anticipated by the cited prior art (see above rejection). Alternatively, it is the examiner's position that 1) the cited prior art does not particularly disclose each species and/or concentration of claimed components; and 2) the prior art does not particularly recognize the claimed dispersion temperature.

As to the first distinction, the selection of an optimal species and/or concentration to achieve an art recognized effect is ordinary within the gambit of ordinary skill in the art.

As to the second distinction, it is noted above for example that Hague teaches a dispersion temp. Of approximately 50 degrees. While it is the examiner's primary position that such a temperature includes values within the range now claimed, alternatively it is the examiner's position that having before him the Hague disclosure, one of skilled in the art would

be motivated to select a dispersion temperature of at least 60 degrees. The motivation do so lies in achieving a similar product with similar utility.

Note that: (i) the cited art is analogous because it pertains to the field of the inventor's endeavor and is also reasonably pertinent to the particular problem with which the inventor is involved. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); (ii) a comprising-type language does not exclude other steps, elements or materials. *Cues Inc. Vs Polymer Industries*, USPQ2d 1847 (DC ND GA 1988); (iii) it is well established that the claims are given the broadest interpretation during examination; (iv) a conclusion of obviousness under 35 USC 103(a) does not require absolute predictability, only a reasonable expectation of success; and (v) references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103(a).

(5) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Raj Bawa, Ph.D., whose telephone number is (703) 308-2423. The examiner can normally be reached on Tuesday-Friday from 7:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Bawa/sg

June 4, 1999

R. Bawa

RAJ BAWA, Ph.D.
PRIMARY EXAMINER